UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,629	02/06/2001	Yoshio Sugimoto	1046.1238 (JDH)	7168

21171   7590   09/03/2008
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EXAMINER
BARQADLE, YASIN M

ART UNIT	PAPER NUMBER
2153	

MAIL DATE	DELIVERY MODE
09/03/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)
Office Action Summary		09/776,629	SUGIMOTO, YOSHIO
		Examiner	Art Unit	
		YASIN M. BARQADLE	2153	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>09 June 2008</u>.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-21 and 23</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1-21 and 23</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Amendment

2.   The amendment filed on June 09, 2008 has been fully considered but are

moot in view of the new grounds of rejection and response to the arguments.

- Claims 1-21 and 23 are presented for examination.

Response to Arguments

The Applicant in essence argues "Bailey does not teach any indicating of a

change and not indicating of a change of the unread/already-read information

corresponding to an unread electronic mail based respectively on a first

command and a second command." Page 9 second paragraph. The examiner

respectfully, disagrees. Bailey teaches commands such as clicking, activating,

highlighting, scrolling etc (see for example col. 4, lines 53 to col. 5, lines 15. In

the case when a message is opened by highlighting or clicking which the

examiner interprets as the first command the status of the list changes as a

read (see fig. 3, item 52. In the case for the second command Bailey teaches "if

the displayed messge does not fit in the preview pane entirely (such as partial

display of the message step 82) the flag remains FALSE (the state remains

unread. Second command is interpreted scrolling where the flag remains false

because the entire message is not displayed. Another command could be also

the expressly override of the user which keeps the status unchanged/unread

col. 5, lines 54-60).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in

this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors

Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology

Technical Amendments Act of 2002 do not apply when the reference is a U.S.

patent resulting directly or indirectly from an international application filed

before November 29, 2000. Therefore, the prior art date of the reference is

determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-

AIPA 35 U.S.C. 102(e)).

1.   Claims 1-6, 8-13 and 15-20 are rejected under 35 U.S.C. 102(b) as being

anticipated by Bailey et al USPN (5835084).

As per claim 1, Bailey et al teach a device for reading electronic mails (device

10, fig. 2), comprising:

a storing unit storing unread/already-read information corresponding to each of received electronic mails [storage 34, stores received unread email messages addressed (received) to a user col. 3, lines 60-67 and col. 4, lines 33-56];

a controller indicating a change of the unread/already-read information corresponding to an unread electronic mail in a case where a body of the unread mail is displayed in response to a first command (highlighted or opened message is indicated as read) and not indicating the change of the unread/already-read information corresponding to the unread electronic mail in the case where a body of the unread mail is displayed in response to a second command (Bailey teaches "if the displayed messge does not fit in the preview pane entirely (such as partial display of the message step 82) the flag remains FALSE (the state remains unread. Second command is interpreted scrolling where the flag remains false because the entire message is not displayed. Another command could be also the expressly override of the user which keeps the status unchanged/unread col. 5, lines 54-60); and a managing module changing the unread/already-read information of the storing unit based on the indicating of the controller [a processor executes a method for distinguishing between read and unread messages col. 5, lines 15-65 and col. 6, lines 21-38. see fig. 3 and abstract].

As per claim 2, Bailey et al teach the device according to claim 1, wherein said

storing unit stores the state of "unread" or a state of "already-read" of a

corresponding electronic mail as the unread/already-read information [col. 5,

lines 10-23]; and

said managing module creates a list in which an electronic mail of

which the corresponding state information stored in said storing unit at a

predetermined timing indicates the state of "unread" is registered (5, lines 54-

65 and col. 6, lines 21-38. see fig. 3), and

said controller executes a process for displaying a registered

electronic mail in said list on a display according to a request for reading the

registered electronic mail [col. 3, lines 60 to col. 4, line 56 and col. 5, lines 1-

14].

As per claim 3, Bailey et al teach the device according to claim 2, wherein said

controller specifies the electronic mail with the state of "unread" on the list

corresponding to the request by use of said list, and displays a body of the

specified electronic mail on said display [fig. 4 and col. 5, lines 1-23].

As per claim 4, Bailey et al teach the device according to claim 1, further

comprising a display controller displaying a screen for searching the electronic

mail with the state of "unread" on the list managed by said managing module

on said display [fig. 3; col. 3, lines 60 to col. 4, lines 7 and col. 5, lines 1-23].

As per claim 5, Bailey et al teach the device according to claim 4, wherein said list holds information of the plurality of registered electronic mails in predetermined sort order [fig. 3, col. 4, lines 33-44];

a pointer is set at any one of the information in said list [fig. 3, and col. 4, lines 45-52]; and

said display controller displays the screen for searching an electronic mail registered next to the registered electronic mail corresponding to the information pointed by the pointer and/or a previous electronic mail of the registered electronic mail corresponding to the information pointed by the pointer [fig. 3, and col. 4, lines 45-52 and col. 6, lines 21-26].

As per claim 6, Bailey et al teach the device according to claim 1, wherein the predetermined timing is a time point of which reading the body of the electronic mail is requested [col. 4, lines 24-65].

As per claims 8, 15 and 22, these are a storage medium and method claims with similar limitations as claim 1 above. Therefore, they are rejected with the same rationale. See the rejection of Claim 1 above.

As per claims 9 and 16, Bailey et al teach the invention wherein said storing

stores the state of "unread" or a state "already-read" of a corresponding

electronic mail as the unread/already-read information [col. 5, lines 10-32],

said managing module creates a list in which an electronic mail of

which the corresponding state information stored in said storing unit at a

predetermined timing indicates the state of "unread" is registered (5, lines 54-

65 and col. 6, lines 21-38. see fig. 3), and the method further comprises a

process for displaying a registered electronic mail in said list on a display

according to a request for reading the registered electronic mail [a processor

executes a method for distinguishing between read and unread messages col.

5, lines 15-38].

As per claims 10 and 17, Bailey et al teach the invention wherein said

controlling specifies the electronic mail with state of "unread" corresponding to

the request by use of said list, and displays a body of the specified electronic

mail on said display [fig. 4 and col. 5, lines 1-23].

As per claims 11 and 18, Bailey et al teach the invention, further comprising

displaying a screen for searching the electronic mail with the state of "unread"

on said display [A list of unread/already ready messages is displayed on list

pane 50 col. 3, lines 60 to col. 4, lines 7 and col. 4, lines 33-56. See fig. 3 and

col. 5, lines 1-54].

As per claims 12 and 19, these claims have similar limitations as claim 5

above. Therefore, they are rejected with the same rationale. See the rejection of

Claim 5 above.

As per claim 13 and 20, Bailey et al teach the invention, wherein the

predetermined timing is a time point of which reading the body of the electronic

mail is requested [col. 4, lines 24-65].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or
> described as set forth in section 102 of this title, if the differences between the subject
> matter sought to be patented and the prior art are such that the subject matter as a whole
> would have been obvious at the time the invention was made to a person having ordinary
> skill in the art to which said subject matter pertains. Patentability shall not be negatived by
> the manner in which the invention was made.

2.   Claims 7,14 and 21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Bailey et al USPN (5835084) in view of Doganata et al USPN

(6728714).

As per claims 7, 14 and 21, although Bailey et al shows substantial features of

the claimed invention including a message window with icon buttons enabling

a user to store, reply, forward and print message, Bailey does not explicitly

show deleting message list on the basis of a request for an end (end command) for reading an electronic mail. Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Bailey et al, as evidenced by Doganata et al USPN (6728714).

In analogous art, Doganata et al whose invention is about System and method for assigning unique identifier to deleted unopened original sender e-mail after delivery, disclose deleting a message list (category of a classified electronic mail) on the basis of a request for an end of reading the electronic mail by a user [Col. 5, lines 15-61. See fig. 3, steps 36-38). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Bailey to support mechanism of deleting a list of electronic mails for advantage of improving storage space.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YASIN M. BARQADLE whose telephone number is (571)272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The

fax phone number for the organization where this application or proceeding is

assigned is 571-273-8300.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

for published applications may be obtained from either Private PAIR or Public

PAIR. Status information for unpublished applications is available through

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http://pair-direct.uspto.gov. Should you have questions on access to the

Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-

9197 (toll-free). If you would like assistance from a USPTO Customer Service

Representative or access to the automated information system, call 800-786-

9199 (IN USA OR CANADA) or 571-272-1000.

/Yasin M Barqadle/
Primary Examiner, Art Unit 2153